REMARKS

Claims 1, 3-10, 12-18, 20-27, and 29-34 are pending in this application. By this Amendment, claims 1, 3, 5, 10, 14, 18, and 27 are amended and claims 2, 11, 19, and 28 are cancelled without prejudice or disclaimer. Claim 1 is amended to clarify claim 2 in independent form. Claim 10 is amended to recite claim 11 in independent form. Claim 18 is amended to recite claim 19 in independent form. Claim 27 is amended to recite claim 28 in independent form. Claims 5 and 14 are amended to obviate the Office Action's objections. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

The Office Action rejects claims 1-3 and 18-20 under the judicially created doctrine of obviousness type double patenting over claims 1-3 and 31 of Pecen et al. (U.S. Patent Pub. No. 2005/0227691) in view of Shaheen et al. (U.S. Patent Pub. No. 2004/0203792). A Terminal Disclaimer is enclosed herewith that disclaims the terminal part of any patent granted on the instant application which would extend beyond the expiration date of the Pecen et al. Accordingly, Applicants respectfully request withdrawal of the rejection under the judicially created doctrine of obviousness type double patenting.

The Office Action rejects claims 5, 12, and 14 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. This rejection is respectfully traversed. Claims 5, 10, and 14 are amended to provide proper antecedent basis for the features of the claims to overcome the rejection under 35 U.S.C. § 112. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

The Office Action rejects, under 35 U.S.C. § 102, claims 1-4, 7-8, 18-20, and 24-25 over Shaheen et al. (U.S. Patent Pub. No. 2004/0203792). The Office Action also rejects, under 35 U.S.C. § 103, claims 5-6 and 22-23 over Shaheen et al. and Boyer et al. (U.S. Patent No. 7,050,812), claims 9 and 26 over Shaheen et al. and Stumpert et al. (U.S. Patent Pub. No. 2004/0157600), claims 10, 11, 16, 17, 21, 27, 33, and 34 over Shaheen et al. and Ovesjo et al. (U.S. Patent Pub. No. 2002/0160785), claims 12, 14, 29, and 30 over Shaheen et al., Ovesjo et al., and Boyer et al., and claims 13, 15, 31, and 32 over Shaheen et al., Ovesjo et al., and Yahagi (U.S. patent No. 7,065,360). These rejections are respectfully traversed.

Applicants assert that Shaheen et al. does not disclose or suggest detecting a presence of a wireless local area network, the wireless local area network being unregistered with the cellular radio access network at initial detection of the presence of the wireless local area network while in the ongoing communication and transferring the ongoing communication from the cellular radio access network to the wireless local area network, as recited in independent claim 1 and similarly recited in independent claim 18.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The Office Action alleges Shaheen et al. teaches "a method in a communication device for handover from a first radio access network UMTS (Fig. 7) to a second radio access network WLAN (Fig. 7)." The Office Action goes on to allege, with respect to claim 2, Shaheen et al. "teaches wherein the first radio access network is a cellular radio access network (UMTS) and wherein the second radio access network is a wireless local area network (Fig. 7 and Sections 0006-0009 and 0039-0043)." Applicants disagree.

Applicant assert the cited sections do not disclose the wireless local area network is unregistered with the cellular radio access network at initial detection of the presence of the wireless local area network, as recited in claim 1, which is now claim 2 recited in independent form, which also recites similar features to current claim 18. In particular, Fig. 7 expressly illustrates the UMTS broadcasts a list of WLANs available to the user equipment in step S2. This is done prior to the user equipment monitoring WLAN channels in step S6. Accordingly, the WLAN must have some sort of registration with the UMTS to be on the list that is broadcast in step S2. Also, the list is broadcast before the user equipment even begins monitoring the WLAN channels. Consequently, Fig. 7 discloses that a wireless local area network is registered with a cellular radio access network prior to initial detection of the wireless local area network. Thus, Fig. 7 and the associated sections do not disclose the wireless local area network is unregistered with the cellular radio access network at initial detection of the presence of the wireless local area network.

Shaheen et al. does disclose, with respect to Fig. 4, that user equipment has its receiver monitor wireless local area network (WLAN) channels, lock onto a WLAN channel, and initiate WLAN service. The WLAN authenticates the user equipment through an authentication procedure with a UMTS system (see paragraphs 0031 and 0032). However, this section still does not disclose the wireless local area network is unregistered with the cellular radio access network at initial detection of the presence of the wireless local area network. In fact, one of ordinary skill in the art would clearly understand that to perform the authentication, the wireless local area network inherently have some sort of registration with the cellular radio access network. More particularly, the WLAN would have to be registered for proper authorization to perform an authentication procedure. Consequently, not only does Shaheen et al not disclose a wireless local area network that is unregistered with the cellular radio access network, Shaheen et al. actually teaches away from the claimed invention.

Thus, Shaheen et al. does not disclose or suggest detecting a presence of a wireless local area network, the wireless local area network being unregistered with the cellular radio access network at initial detection of the presence of the wireless local area network while in the ongoing communication and transferring the ongoing communication from the cellular radio access network to the wireless local area network, as recited in independent claim 1 and similarly recited in independent claim 18.

Applicants further assert that Shaheen et al. and Ovesjo et al do not disclose or suggest receiving a measurement report including a fictitious neighbor value, as recited in independent claim 10 and similarly recited in independent claim 27.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

Ovesjo et al. discloses inter-radio access technology (RAT) handover for wireless telecommunications. Basic actions involved in an inter-RAT handover procedure include a measurement report being sent from a mobile terminal 30 to a base station controller 26. The measurement report includes measurements, such as signal strength, for selected channels of a first radio access network. The measurement report also includes measurements of selected channels for a second radio access network (paragraph 0037). Contrary to claims 10 and 17, the measurement report does not include a fictitious neighbor value. In particular, measurements, such as signal strength measurements of the first and second radio access networks are actual measurements. They are not fictitious measurements.

The fact that Ovesjo et al. does not disclose receiving a measurement report including a fictitious neighbor value is further illustrated by the criteria disclosed in Ovesjo et al. to initiate an inter-RAT handover. In particular, Ovesjo et al. discloses an inter-RAT handover can be initiated when the quality of the downlink radio connection with the first radio access network, as reported by the measurement report message, falls below a predetermined threshold (paragraph 0038). This is not a fictitious neighbor value. It is an actual value because it is the quality of the downlink radio connection that is reported in the measurement report message.

Shaheen et al. fails to make up for the deficiencies of Ovesjo et al. and such is not alleged by the Office Action.

Thus, Shaheen et al. and Ovesjo et al do not disclose or suggest a receiving a measurement report including a fictitious neighbor value, as recited in independent claim 10 and similarly recited in independent claim 27.

Therefore, Applicants respectfully submit that independent claims 1, 10, 18, and 27 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1, 3-10, 12-18, 20-27, and 29-34 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,

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